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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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09/842,613 04/26/01 TAYLOR

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EXAMINER

IM22/0921

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ART UNIT

PAPER NUMBER

1714
DATE MAILED:

09/21/01

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.

09/042,613

Applicant(s)

Taylor

Examiner

T. Yoon

Group Art Unit

1714

—The MAILING DATE of this communication appears on the cover sheet beneath the correspondence address—

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE three MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, such period shall, by default, expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- ☒ Responsive to communication(s) filed on 4-26-01, Re Amended
- ☐ This action is **FINAL**.
- ☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

- ☒ Claim(s) 1 and 11-26 is/are pending in the application.
- Of the above claim(s) _____ is/are withdrawn from consideration.
- ☐ Claim(s) _____ is/are allowed.
- ☒ Claim(s) 1 and 11-26 is/are rejected.
- ☐ Claim(s) _____ is/are objected to.
- ☐ Claim(s) _____ are subject to restriction or election requirement

Application Papers

- ☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.
- ☐ The drawing(s) filed on _____ is/are objected to by the Examiner
- ☐ The specification is objected to by the Examiner.
- ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119 (a)-(d)

- ☒ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119 (a)-(d).

☒ All ☐ Some* ☐ None of the:

☐ Certified copies of the priority documents have been received.

☒ Certified copies of the priority documents have been received in Application No. 09/776,264.

☐ Copies of the certified copies of the priority documents have been received in this national stage application from the International Bureau (PCT Rule 17.2(a))

*Certified copies not received: _____

Attachment(s)

- ☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). _____
- ☒ Notice of Reference(s) Cited, PTO-892
- ☐ Notice of Draftsperson's Patent Drawing Review, PTO-948
- ☐ Interview Summary, PTO-413
- ☐ Notice of Informal Patent Application, PTO-152
- ☐ Other _____

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A rejection based on double patenting of the "same invention" type finds its support in the language of 35 U.S.C. 101 which states that "whoever invents or discovers any new and useful process ... may obtain a patent therefor ..." (Emphasis added). Thus, the term "same invention," in this context, means an invention drawn to identical subject matter. See *Miller v. Eagle Mfg. Co.*, 151 U.S. 186 (1894); *In re Ockert*, 245 F.2d 467, 114 USPQ 330 (CCPA 1957); and *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970).

A statutory type (35 U.S.C. 101) double patenting rejection can be overcome by canceling or amending the conflicting claims so they are no longer coextensive in scope. The filing of a terminal disclaimer cannot overcome a double patenting rejection based upon 35 U.S.C. 101.

Claims 1 and 11-26 are provisionally rejected under 35 U.S.C. 101 as claiming the same invention as that of claims 1 and 11-26 of copending Application No. 09/232,110. This is a provisional double patenting rejection since the conflicting claims have not in fact been patented.

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 1 and 11-26 are rejected under 35 U.S.C. 112, first paragraph, because the specification, while being enabling for a water-resistant film-forming composition at ambient temperatures comprising 10 wt% of a film-forming acrylic latex and 90 wt% of a polyhydroxyalkanoate ((co)polyester) as in the examples 1 and 2, does not reasonably provide enablement for the instant claim reciting a (co)polyester. The specification does not enable any

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person skilled in the art to which it pertains, or with which it is most nearly connected, to make the invention commensurate in scope with these claims.

The instantly recited polyhydroxyalkanoate (co)polyester encompasses an amorphous (co)polyester (non-crystalline (co)polyester in another words), and note applicant's statement in the bridging paragraph on pages 5 and 6 of the Appeal Brief for 09/232,110 wherein the relationship of the density and the crystallinity is stated. Thus, a non-crystalline or an amorphous (co)polyester would have the lowest density) which will neither crystalize nor fuse at ambient temperatures. There is no evidence that said (co)polyester alone forms a water-resistant film or fuse at ambient temperatures. The film of the instant examples of the specification is due to the presence of 10 wt% of a film-forming acrylic latex. The examples do not commensurate in scope with the claim. Note that the requirement in the claim 1 is only an aqueous (co)polyester and that the dependent claim 13 reciting other film forming polymers does not have any amount thereof. Thus, even the presence of 0.1 or 1 wt% of said other film forming polymers or no presence of said other film forming polymers falls within the scope of the instant invention, but applicant failed to show a film fomation therefrom. Also, as pointed out by applicant in said Appeal Brief for 09/232,110 (example 1 of Marchessault), the non-crystalline polyester forms a film with little or no strength (little or no fusion) at ambient temperature which rebuts appellant's claimed fusion at ambient temperature and appellant's own argument that said aqueous (co)polyester alone would form a water-resistant a film at ambient temperatures.

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Claims 15-17 and 22-24 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

This is New Matter rejection since the recited “the polyhydroxyalkanoate polyester comprising monomers with high minimum film-forming temperature and monomers with low minimum film-forming temperatures” in claim 15 has no support in the originally filed specification.

During the prosecution of 09/232,110, applicant had cited lines 2-6 of page 8 of the specification for the support, but, said lines 2-6 of page 8 are related to film-forming temperatures for additional film-forming polymers, and **not for the instant (co)polyester** as discussed by the examiner in 09/232,110. Also, said film-forming temperatures are related to the polymer of monomers, and not to monomers. Monomers do not form a film.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 15-17 and 22-24 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

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The recited “monomers with high minimum film-forming temperature” and “monomers with low minimum film-forming temperatures” are indefinite in not specifying particular temperatures since there is no definition of said high minimum and low minimum film-forming temperatures in the specification. Note that monomers do not form a film.

The lines 1-2 of page 8 discloses ASTM test 2354-91, and applicant has submitted a copy of ASTM test 2354-98 which is stated as the latest revision of the same test with the response filed on June 30, 2000 for 09/232,110. Said ASTM D 2354-98 shows a measurement of the minimum film-forming temperature, but it does not teach the recited high and low minimum film-forming temperatures. Thus, said high and low are indefinite since they are relative expressions.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1 and 11-26 are rejected under 35 U.S.C. 103(a) as being unpatentable over Marchessault et al (US 5,451,456 or WO 91/13207).

The examiner points out US'456 since US and WO are the same.

Marchessault et al teach the instant latex composition comprising non-crystalline particles in abstract and at col. 6, lines 44-50 and a coating thereof in examples. Pigments are taught at

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col. 6, line 68. Marchessault et al also teach employing up to 10 parts by weight of the solids of other latex polymers and copolymers at col. 7, lines 13-18. Styrenebutadiene copolymer is obtained from monomers, styrene and butadiene, obtained from petroleum (or oil) fractionation.

The instant invention further recites a method of coating surfaces such as one found on buildings over the cited art which teaches coatings on papers and synthetic latex polymer. However, one can see many paper coverings (wall papers or surface of gypsum boards which are also called "dry-wall") on surfaces of buildings.

It would have been obvious to one of ordinary skill in the art at the time of invention to utilize the coating composition comprising a polyhydroxyalkanoate (co)polyester and a room temperature film-forming latex polymer in Marchessault et al since Marchessault et al teach employing other latex polymers and copolymers, and since a room temperature film-forming paint is a routine in the art and can be found in any hardware store, and further to use the paint thereof on paper covering on surfaces of buildings since the use of a coating composition on various surfaces is considered a routine practice and since many surfaces of buildings are papers absent showing otherwise.

Claims 1 and 11-26 are rejected under 35 U.S.C. 103(a) as being unpatentable over Marchessault et al (US 5,451,456 or WO 91/13207) in view of Miyagawa et al (US 4,016,306).

The instant invention further recites monomers for high and low minimum film-forming temperature even though the recitation is confusing as discussed above. However, Marchessault

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et al also teach employing up to 10 parts by weight of the solids of other latex polymers and copolymers such as styrenebutadiene and water soluble polymers at col. 7, lines 13-18. Note that syrene meets the instant non-acidic monomer for high minimum film-forming temperature. Miyagawa et al teach an aqueous film forming composition comprising an acrylic copolymer at col. 6, lines 29-68 wherein copolymers of (meth)acrylic acid, ethyl acrylate and methyl methacrylate are taught.


It would have been obvious to one of ordinary skill in the art at the time of the instant invention to utilize an acrylic copolymer of Miyagawa et al in Marchessault et al since Marchessault et al teach employing latex water soluble copolymers and since the use of an acrylic copolymer of (meth)acrylic acid, ethyl acrylate and methyl methacrylate in an aqueous film forming composition is a routine in the art.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Tae H. Yoon whose telephone number is (703) 308-2389. The examiner can normally be reached on Monday to Thursday from 8:00 to 5:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vasu Jagannathan, can be reached on (703) 306-2777. The fax phone number for the organization where this application or proceeding is assigned is (703) 305-5408.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0661.

THY/September 20, 2001


TAE H. YOON
PRIMARY EXAMINER